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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,214	04/14/2004	John F. Burd	OCULIR04	6280
27189	7590	12/23/2004	EXAMINER	
PROCOPIO, CORY, HARGREAVES & SAVITCH LLP			KREMER, MATTHEW J	
530 B STREET			ART UNIT	
SUITE 2100			PAPER NUMBER	
SAN DIEGO, CA . 92101			3736	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/824,214

Applicant(s)

BURD ET AL.

Examiner

Matthew J Kremer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-11 and 13 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>112204; 100404</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on 10/05/2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Pat. Application 10/428,410 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,178,917 to Shapiro. Shapiro teaches using a light source to illuminate the conjunctiva, detecting the reflected light from the region, and determining the concentration of ZPP in the erythrocytes from the reflected light. (column 1, line 50 to column 2, line 9 of Shapiro).

4. Claims 1-3 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,998,533 to Winkelman. Winkelman teaches using a light source to illuminate the conjunctiva, detecting the reflected light from the region, and determining

various analytes from the reflected light. (Fig. 1 and column 8, lines 27-40 of Winkelman). In regard to claims 8-9, filters and computers are used. (Abstract of Winkelman).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,178,917 to Shapiro as applied to claim 1, and further in view of U.S. Patent Application Publication 2002/0049389 to Abreu. In regard to claim 5, Shapiro teaches that other wavelengths can be used. (column 4, lines 22-26 of Shapiro). Abreau teaches that mid-infrared wavelengths are suitable wavelengths when analyzing eye constituents. (paragraph 0276 of Abreu). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the mid-infrared wavelengths of Abreu in the invention of Shapiro since Shapiro teaches that other wavelengths can be used and Abreu teaches such wavelengths. In regard to claim 9, Shapiro teaches the use of a combining network 16 for receiving detector signals and generating a signal representative of a concentration of ZPP. (column 3, lines 15-21 of Shapiro). Shapiro does not teach the particulars of the combining

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network. Abreu teaches a computer that analyzes detector signals to achieve analyte concentrations, which would fulfill the requirements of providing a combining network 16 as set forth in Shapiro. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the computer of Abreu in the invention of Shapiro since Shapiro teaches the use of a combining network to achieve a concentration value from detector signals and Abreu teaches one such combining network. In regard to claim 13, Abreu teaches downloading measurements to a computer system (a hospital based computer system) for examination by hospital personnel without having the patient go to the hospital. (paragraphs 0151 and 0272 of Abreu). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to download measurements to a computer system as disclosed by Abreu since such downloading allows hospital personnel to examine the measurements without having the patient go to the hospital.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,178,917 to Shapiro as applied to claim 1. Shapiro teaches using multiple detectors, one of which is used to detect reflected light. (column 2, lines 1-4 of Shapiro). Although Shapiro does not teach the specifics of this particular detector, Shapiro teaches that such detectors include filters to limit the detector response to particular wavelength ranges. (column 2, lines 55-58 of Shapiro). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use

the filters in front of the detectors since such filters limit the detector responses to particular wavelength ranges.

8. Claims 6 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,178,917 to Shapiro in view of U.S. Patent Application Publication 2002/0049389 to Abreu, and further in view of U.S. Patent 6,039,697 to Wilke et al. (Wilke). Shapiro teaches that other wavelengths can be used. (column 4, lines 22-26 of Shapiro). Abreau teaches that mid-infrared wavelengths are suitable wavelengths when analyzing eye constituents. (paragraph 0276 of Abreu). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the mid-infrared wavelengths of Abreu in the invention of Shapiro since Shapiro teaches that other wavelengths can be used and Abreu teaches such wavelengths. The combination teaches that mid-infrared radiation is used (paragraph 0276 of Abreu) but does not teach specific wavelengths. Wilke teaches suitable wavelengths that are between 4-8 microns (column 4, lines 25-34 of Wilke), which would fulfill the requirements of providing mid-infrared wavelengths as set forth in Abreu. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the wavelengths as disclosed by Wilke since Abreu teaches that mid-infrared wavelengths can be used and Wilke teaches such wavelengths.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1-3, and 5-11, and 13 have been considered but are moot in view of the new ground(s) of rejection.

***Allowable Subject Matter***

10. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter. The prior art does not teach or suggest that the analyte is glucose that is combined or combinable with the other limitations of claim 4.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

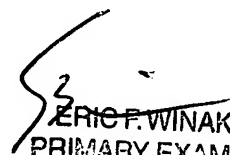
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J Kremer whose telephone number is 571-272-4727. The examiner can normally be reached on Mon. through Fri. between 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew Kremer  
Assistant Examiner  
Art Unit 3736

  
ERIC F. WINAKUR  
PRIMARY EXAMINER